UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,917	07/03/2001	Siu-Leong Iu	GOGL-399-B	3640

97818 7590 04/17/2013

Young Basile Hanlon & MacFarlane P.C.
3001 West Big Beaver Road
Suite 624
Troy, MI 48084-3107

EXAMINER	
WINTER, JOHN M	
ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
04/17/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@youngbasile.com
audit@youngbasile.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SIU-LEONG IU, MALCOLM DAVIS, HUI LUO, YUN-TING LIN, GUILLAUME MERCIER, and KOBAD BUGWADIA

Appeal 2011-012787
Application 09/763,917
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 19-30 and 62-77 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to data protection by a digital watermark system for multimedia content (Spec.1:5-7). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter on appeal.

> 19. A playback unit, comprising:
> an input for receiving an encoded data stream bearing a video image;
> a decoder for decoding the encoded data stream; and
> [1] means for imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer, [2] wherein
> said warping changes with time during playback of the video image.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Chaum	US 5,959,717	Sep. 28, 1999

Saito	US 6,182,218 B1	Jan. 30, 2001
Rhoads	US 6,363,159 B1	Mar. 26, 2002

The following rejections are before us for review:

1. Claims 19-30 and 62-77 are rejected under 35 U.S.C. § 112, second paragraph.

2. Claims 19-30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Rhoads, Saito and Chaum.

3. Claims 62-77 are rejected under 35 U.S.C. § 103(a) as unpatentable over Rhoads and Chaum.

FINDINGS OF FACT

We find that the findings of fact used in the Analysis section below are supported at least by a preponderance of the evidence.[1]

ANALYSIS

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner has determined that in claim 19 that the phrase for warping the video image by an amount "not readily visible to a viewer" is indefinite because it fails to quantify the amount of warping of the video image (Ans. 5, 12).

In contrast, the Appellants argue that this rejection is improper (App. Br. 5-7, Reply Br. 2-3).

[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

We agree with the Appellants. One of ordinary skill in the art would understood what the phrase "not readily visible to a viewer" referred to in light of the Specification (at, for example, at page 36, lines 8-11 or Figure 1 (reference numeral 104b)), which describes the use of watermarks that are not visible by a user but can be detected by hardware and the use of a tracing watermark inserter. For these reasons this rejection is not sustained. The Examiner has provided the same rationale for the remaining claims and the rejection of these claims is not sustained for the same reasons.

Rejections under 35 U.S.C. § 103(a)

The Appellants argue that the cited prior art fails to disclose or suggest claim limitation [1] cited above (App. Br. 9-11). Claim limitation [1] requires:

> [1] means for imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer.

The Examiner cites to Rhoads as imparting transformation to a video image and to Saito for showing a decoder (Ans. 5-7). The Examiner has determined that the claim limitation to show "such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer" is shown by Chaum at column 8, line 57-column 9, line 9. The Examiner has also determined that it would it would have been obvious to combine the cited teachings "in order to enforce digital rights management systems" (Ans. 6).

We agree with the Appellants. Rhoads does disclose using a repeated noise signal onto an image to indicate the presence of copyrighted material (col. 28, ll. 24-26). The citation to Rhoads in the Answer makes no mention of the elements of claim limitation [1] directed to "a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer." While Chaum at column 8, line 5-column 9, line 9 describes that media may be split into two or more recorded parts this is not directed to warping of a composite video image produced by multiple video playback units in the manner claimed. Here, there is no articulated reasoning with rational underpinnings for making the cited combination of the references to meet the limitations of the claim and this rejection of claim 19 is not sustained. Claims 20-30 contain a similar claim limitation and the rejection of these claims is not sustained for these same reasons.

Claims 62-77 contain a similar claim limitation and the rejection of these claims is also not sustained for the same rationale given above.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting the claims as listed in the Rejections section above.

DECISION

The Examiner's rejection of claims 19-30 and 62-77 is reversed.

REVERSED

mls